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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,873	03/04/2002	Katsuhisa Inoue	220137US0	1799

22850 7590 12/03/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,873

Applicant(s)

INOUE ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 31, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7, 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of group I, claims 1-5 in Paper No. 15 is acknowledged. The traversal is on the ground(s) that compounds in group III do not have any utility per se; and that examiner's proposed alternative method of making amine cannot be carried out. This is not found persuasive. In this case, applicants' argument that "compounds" do not necessarily have any particular utility per se is not well taken. Utility patents are granted to inventors of new and useful compounds, which is what applicants are believed to seek in this case. The evidence of record to show that compounds have utilities are found in applicants' disclosure. See spec. p. 74, comparative amines. Applicants' argument that there is no evidence of record to show there are alternative method to produce amine is also unpersuasive because the prior arts disclosed by applicants are also related to production of amines. See US 3223700.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites that q and r in formula (I) are 0 or 1. That limitation renders that claim vague and indefinite because when either or both q and r are 0, the nitrogen atom which is adjacent to the R3 and R4 radicals cannot have balanced electrons.

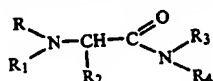
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Roncucci et al. (US 4639468).

Roncucci discloses a glycinamide derivative having the general formula and the constituents, which are the species of the genus of the instant invention. See abstract.

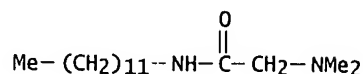


For example, the limitation of the instant claims encompasses the prior art amide when R is a linear or branched alkyl group C5-18; R1 hydrogen; R2 a linear or branched alkyl C1-3; R3 and R4 hydrogen, linear or branched alkyl groups C1-8. The reference teaches that the amide added in pharmaceutical compositions, thus meeting the composition limitation. See col. 4, lines 18-53. The recitation of "hair cosmetic" is viewed a mere preamble which recites intended use or purposes of the composition. Thus no patentable weight is given to the term.

2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitzing et al. (CAPLUS 1986:19816).

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Kitzing teaches that cosmetic composition comprising 2-(dimethylamino)-N-dodecyl-acetamide as shown below is well known in the art. See abstract.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

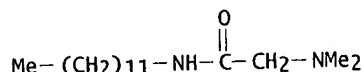
1. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu (WO 98/40046) in view of Schmadel (CAPLUS 1967:455359).

Mitsumatsu teaches hair conditioning composition comprising from about 0.4 to 5 of an amido amine; from about 0.05-20 % by weight of an inorganic or organic acid; and

Mitsumatsu teaches hair conditioning composition comprising from about 0.4 5 of an amido amine; from about 0.05-20 % by weight of an inorganic or organic acid; and from about 1-15 % by weight of fatty alcohol having 12-22 carbon atoms. See abstract; page 3, line 22 – page 5, line 32.

The reference fails to teach the amine of the instant claims.

Schmadel teaches that a surfactant having formula



is well known in cosmetic art. See abstract. The reference teaches that the surfactants improve foam stability, are mild, and particularly suitable for cosmetic preparation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Mitsumatsu by substituting the Schmadel amine with the amido amine as motivated by Schmadel because of an expectation of successfully producing a mild hair rinse composition with foam stability.

Conclusion

No claims are allowed.

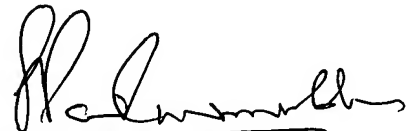
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

12/1/03